REMARKS

Claims 89-111 are pending and at issue in the above identified patent application. Claims 89 and 99 have been amended and claims 102-111 have been newly added. Of the claims at issue, claims 89, and 101 are independent. Newly introduced claims 102-111 general conform to selected claims as originally filed, but canceled without prejudice. Accordingly, no new matter has been added. In view of the foregoing amendments and the following remarks, reconsideration of the application is respectfully requested.

The Rejection under 35 U.S.C. § 112

Claim 100 stands rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. In particular, claim 100 included language directed to both a continuous and a discontinuous shape. Claim 100 has been amended to be directed to a continuous shape. Claim 102 has been newly added and is directed to a discontinuous shape. The foregoing should eliminate any rejection under 35 U.S.C. §112 that may have been proper.

The Rejections under 35 U.S.C. § 103

Claims 89-101 were rejected as being unpatentable over Davis (US Publication No. 2003/0167658) in view of either Fellman (US 2,383,117) or Minges (6,544,626). As explained below, the rejections are respectfully traversed. Reconsideration and withdrawal of the rejections are requested.

Claims 89 and 101 are generally directed to a shoe upper including one or more resilient deformable protrusions. In particular, claim 89 recites, *inter alia*, "a shoe upper comprising one or more resiliently deformable protrusion extending from an outer surface of the shoe upper… where each protrusion includes at least an inner contoured shape portion and an outer shaped contoured shape portion each extending form the outer surface of the shoe upper." Similarly, claim 101 recites, *inter alia*, a "kit for a shoe upper" comprising "one

or more resiliently deformable protrusions, in which each protrusion includes at least an inner contoured shape portion and an outer contoured shape portion, and where the outer contoured shape portion is deformable so as to promote engagement of the protrusion with the ball...and the one or more protrusions extend from an outer surface of the shoe upper, and are positioned for contact with a ball." As such, all of these recitations indicate that the protrusion includes an inner and outer countoured shape extending from an outer surface of a shoe upper.

Claims 89-101 were rejected as obvious over Davis in view of either Fellman or Minges. However, neither Davis, Fellman, nor Minges, either alone or in combination, teaches or suggests an inner and outer contoured shape extending from an outer surface of a shoe upper.

While the Supreme Court has rejected a rigid application of the "teaching, suggestion, or motivation" test, which required some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed, the Court noted, however, that the analysis supporting a rejection under 35 U.S.C. §103(a) should be made explicit. More particularly, the Court noted that it was "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007).

The present action, identifies at least two different references that must be combined in order to support the rejection of the claims. Moreover, as will be discussed below, each of the references must be combined in a way that modifies the functionality of the reference teachings. While the Office has identified at least a cursory reason for possibly combining the references, the Office has failed to identify any reason as to how a person of ordinary skill in the art would look to combined the teachings as suggested. Accordingly, the applicants

respectfully traverse the present rejections, and request reconsideration and allowance of the pending claims.

Specifically, Davis is directed toward a football boot having a frictional upper surface (*Davis;* Abstract, paragraph 0018). Davis fails to teach or suggest a resiliently deformable protrusion having an inner contoured shaped portion and an outer contoured shape portion as claimed. The failure of Davis to describe inner and outer contoured shape portions is admitted in the Office action. (*Office action*, Page 2).

To overcome the deficiencies of Davis, the Office attempts to utilize the description of either Fellman or Minges. In particular, the action suggests that it would have been obvious to use the shapes/patterns as taught by Fellman or Minges "to provide look/design for the shoe." (*Office action*, page 3).

Fellman, however, was issued in 1942 as is directed to a treaded shoe sole and heel. (*Fellman*, col. 1, ll. 1-8). Specifically, Fellman is directed to a plurality of gripping surfaces disposed on the sole of the shoe and provided for wet weather gripping. (*Fellman*, col. 1, ll. 9-27). In operation, the wearer's weight forces the ribs of the tread through a moisture film formed on the wet surface so that the moisture travels into the grooves and the ribs make contact with the relatively dry surface beneath, thus providing grip in wet conditions. (*Fellman*, col. 2, ll. 31-42). That is, the grooves and ribs of Fellman are implemented on the sole of the shoe, which, of course, is not a shoe upper as claimed for the express purpose of providing a wet weather grip between the sole and the ground. Further, the gripping surfaces of Fellman are disposed on a relatively flat surface (i.e., the sole), where the weight of the wearer is transferred slowly as the foot is pushed down on the walking surface. Again, this is contrary to the recitations in the claim which are directed to the transient nature of engaging a shoe upper with the surface of a ball.

Similarly, Minges is directed to the use of gripping surface on the sole of the shoe, or on the portion of a glove which corresponds to the inside of a hand. (*Minges*, FIG. 1-5, FIG. 6, col. 2, ll. 13-52). As with Fellman, Minges fails to contemplate the transient engagement or momentary support of a ball on a shoe upper. Furthermore, the gripping surfaces of Minges are either disposed on a relatively flat plane such as the sole of a shoe, or a glove where the inner surfaces of the fingers and thumb are brought together to clench a tool. Where the gripping surfaces of Minges are disposed on a mechanical device such as pliers, it is the inner surface which are brought together to engage and hold an item.

The Court did not suggest that an examiner may ignore, or contradict, the teachings of the prior art when stating a case for obviousness. Rather, in determining obviousness, the proper analysis is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts (35 U.S.C. 103(a)). Perhaps the most compelling of those facts are the teachings of the prior art at issue. When those teachings lead away from the proposed combination, then a *prima facie* case of obviousness has not been established. Additionally, the Court emphasized that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." (Id. at 1741, and MPEP 2143).

As noted above, one of ordinary skill in the art would not have been motivated to combine the teachings of a shoe sole wet weather gripping surface of Fellman or a shoe sole gripper surface of Minges with the friction surface teachings of Davis. In sharp contrast, as noted above, the claims are directed to deformable protrusions present on a generally convex shoe upper and designed to momentarily support or transiently engage a shoe upper with a ball during play. Therefore, one of ordinary skill in the art would not look to the functional gripping surfaces of either Fellman or Minges to provide an asthetic look and/or design for the shoe of Davis, because each of the gripping surfaces of Fellman and Minges provides a

different function, and neither is for pure design. Therefore, despite the suggestion by the Office, there would be no reason that would have prompted a person of ordinary skill in the relevant field to combine the gripping surfaces of either Fellman or Minges with the teachings of Davis, and thus, a *prima facie* case of obviousness has not been established.

Accordingly, in view of the foregoing, the applicants respectfully submit that pending claims 89-111 are in condition for allowance and favorable reconsideration is respectfully requested.

Conclusion

Reconsideration of the application and allowance thereof are respectfully requested. If there is any matter that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

The Commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required during the pendency of this application to Deposit Account No. 50-2455.

Respectfully submitted,

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